

REMARKS

In the Final Office Action, the Examiner rejected pending claims 1-3, 5-25, 27-50, 52-54, and 56-58. In view of the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Response to Arguments

The Final Office included a “Response to Arguments” section beginning on page 17 and ending on page 21. In this section, the Examiner focused on the data rather than its function and interrelationship with the resulting report to enable a client to evaluate a prospective purchase option. For example, the Examiner stated:

Thus, the recitation of “operational data of medical imaging systems” and “medical-imaging-device purchasing analysis form”, these information neither enhance nor diminish the functionality of the system. These information are nothing but a compilation of data, which coincides with the definition of non-functional descriptive material in MPEP 2106. In conclusion, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Final Office Action, page 18 (emphasis added).

First, the Applicants note that Section 2106 of the Manual of Patent Examining Procedure relates generally to 35 U.S.C. § 101. If the Examiner intended to reject the claims under 35 U.S.C. § 101 as non-statutory subject matter, then the Applicants respectfully urge the Examiner to formulate another non-final Office Action to enable the Applicants to appropriately respond to such a rejection. Otherwise, the Applicants respectfully request the Examiner to cite specific law in support of the Examiner’s position above. Even in Section 2106, the Manual of Patent Examining Procedure states:

VI. DETERMINE WHETHER THE CLAIMED INVENTION
COMPLIES WITH 35 U.S.C. 102 AND 103

Reviewing a claimed invention for compliance with 35 U.S.C. 102 and 103 begins with a comparison of the claimed subject matter to what is known in the prior art. See MPEP § 2131 - § 2146 for specific guidance on patentability determinations under 35 U.S.C. § 102 and 103. If no differences are found between the claimed invention and the prior art, then the claimed invention lacks novelty and is to be rejected by USPTO personnel under 35 U.S.C. 102. Once differences are identified between the claimed invention and the prior art, those differences must be assessed and resolved in light of the knowledge possessed by a person of ordinary skill in the art. Against this backdrop, one must determine whether the invention would have been obvious at the time the invention was made. If not, the claimed invention satisfies 35 U.S.C. 103.

M.P.E.P. (Rev. 5, August 2006) § 2106, pages 2100-14 and 2100-15 (emphasis added).

The Applicants respectfully remind the Examiner that Section 2143.03 of the Manual of Patent Examining Procedure states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

M.P.E.P. (Rev. 5, August 2006) § 2143.03, page 2100-131 (emphasis added). Clearly, the Examiner is disregarding certain features of the claims, rather than considering all words of the claims. In view of the passage above, the Examiner's rejections are improper and cannot stand.

Second, the Applicants stress that the claims clearly correlate the data to a specific function, which is missing from the Eder reference. For example, the claims generally relate to a prospective purchase of medical equipment, and a report to enable a client to evaluate the feasibility of such a purchase. Specifically, independent claim 1 recites, *inter alia*, "analyzing a prospective purchasing option selected from a plurality of different

purchasing options to obtain the prospective medical imaging system based on the financial data of the client to provide a client-specific financial analysis of the prospective purchasing option.” Specifically, independent claim 19 recites, *inter alia*, “the financial analysis system is configured to evaluate the client data and to generate a projected financial report for the prospective medical imaging system tailored to the client data, wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging system.” Specifically, independent claim 34 recites, *inter alia*, “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system for incorporation into operations of the client at the healthcare facility.” Specifically, independent claim 43 recites, *inter alia*, “an Internet results page for displaying a projected financial statistic from the financial analysis system, wherein the projected financial statistic indicates a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction.”

In sharp contrast, the Eder reference merely discloses general business evaluation, rather than anything related to a specific purchase transaction. Even outside the context of medical equipment, the Eder reference clearly fails to teach or suggest analysis of a prospective purchase transaction in which operational data of the equipment is analyzed in the process. Although the Applicants do not intend or suggest that the specification should be read into the claims, the Applicants submit that the specification provides context and meaning to the claims. For example, the specification discloses:

The medical resources employed at a particular medical institution greatly impact the efficiency, cost and revenue associated with a desired medical procedure. For example, a current system may allow a procedure to be completed in 20 minutes with 10 minutes of setup time, while another system may complete the procedure in 10 minutes with only 2 minutes of setup time. Less time means more procedures, and thus more revenue and lower patient waiting time for the procedures. As medical technology advances, particularly in the area of electronics and computer aided instruments, medical institutions must evaluate the feasibility of investing

in new, additional or upgraded medical resources to better serve patients and become more efficient and profitable.

...

Unfortunately, the seller may provide limited options for purchasing the desired medical resource, and may not readily provide a prospective purchaser (e.g., the medical institution) with such information. The seller may simply ignore the financial position of the prospective purchaser, and offer a standard transaction option not suitable or feasible for that purchaser.

...

Accordingly, there is a need for a technique for analyzing a desired medical resource investment for a medical institution based on financial data from the medical institution, and for providing a plurality of transaction options tailored to the financial data. More particularly, there is a need for a financial analysis system allowing interactive exchange of information, such as client data and transaction options, between a remote client interface and the financial analysis system via a network.

Application, page 1, lines 18-27; page 3, lines 8-12 and 25-30; page 4, line 1. In view of these passages, the Applicants stress that the present claims recite prospective purchasing options that are client-specific or tailored to the client based on the client's data, e.g., operational data associated with the relevant equipment. The Eder reference simply fails to teach or suggest such a system and method.

Third, the Examiner asserted that certain claim features are merely an intended use, and that the Eder reference teaches a system capable of performing such an intended use. *See* Final Office Action, page 17. However, the Applicants stress that the present claims recite much more than a mere intended use of the Eder system in the field of medicine. Again, the Eder reference does not teach or suggest a prospective purchase analysis for a specific piece of equipment, much less a piece of medical equipment. For example, not only is the Eder reference missing a "device purchase-analysis form," but the Eder reference is missing a "medical-imaging-device purchase-analysis form" as recited in claim 1. The claim does not merely recite a generic form for use with medical data, but the

form itself is specifically claimed as a “medical-imaging-device purchase-analysis form.” Although Eder may include some sort of forms that could hypothetically be used with medical data, the Eder reference clearly fails to disclose the specific type of form recited in the present claims, e.g., “medical-imaging-device purchase-analysis form.” Moreover, the Eder reference fails to disclose use of forms for purchase analysis of specific equipment. For at least these reasons, among others, the Applicants stress that the Examiner’s rejection is improper and cannot stand.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3, 5-25, 27-50, 52-54, and 56-58 under 35 U.S.C. § 103(a) as being unpatentable over Eder (US Patent 6,321,205, hereinafter “Eder”). Applicants respectfully traverse this rejection.

Legal Precedent

First, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is “the primary basis for construing the claims.” See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *id.*

Second, interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. “The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v.*

ApplyYourself, Inc., No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” *See id.*

Third, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “‘well within the ordinary skill of the art’” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Fourth, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Fifth, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

Sixth, in order to rely on equivalence as a rational supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *see also* M.P.E.P. § 2144.06.

Features of Independent Claim 1 Missing From Eder

Claim 1 recites “providing an electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system”. Further, the form is “configured to enable entry of financial data including system operational data for the prospective medical imaging system.”

In contrast, the Eder reference fails to teach or suggest an “electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system.” Nor does Eder teach system operational data for the medical imaging system. Eder discloses *general non-medical* user inputs which define data fields used by software. *See* col. 18, lines 12-20. The software taught by the Eder reference is directed towards extracting, aggregating and storing transaction data associated with *intangible* assets. *See*, Eder, col. 8, lines 1-10; col. 5, lines 12-15. Hence, the forms taught by Eder are incapable of accommodating system operational data of a medical imaging system. For example, system operational data include a variety of operational data determined by the medical imaging system’s specification, such as operational and maintenance cost, patient throughput, availability, etc. These parameters are specific to a medical imaging system and cannot be covered by the forms provided by Eder. Further, in rejecting the claims, the Examiner pointed out instances in which Eder discloses system operational data. *See* Final Office Action, page 4. Applicants contend that no such disclosure appears to be found in the Eder reference. Therefore, Applicants request the Examiner to further clarify where such disclosure exists in the Eder reference. Absent any such disclosure, the rejection of claim 1 cannot stand.

Further, claim 1 recites “analyzing a prospective purchasing option...to obtain the prospective medical imaging system”, based on the financial data of the client “to provide a client-specific financial analysis of the prospective purchasing option.” In contrast, the Eder reference discloses generic purchasing subsystems, wherein “[t]hese systems incorporate worksheets, files, tables and databases...[that] contain information about the

company operations and its related accounting transactions.” *See, e.g., Eder, col. 12, lines 57-60; see also table 6.* Thus, the systems disclosed by the Eder reference are not specifically tailored for analyzing a prospective purchase of a system, much less a medical imaging system.

In addition, the Examiner rejected the claims on grounds of intended use as applied to a medical facility. *See* Final Office Action, page 2. Applicants submit that the rejection cannot stand on such grounds because Eder simply does not disclose a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system, as recited by claim 1. Consequently, the features of claim 1 recited and discussed above are integral with and stem from the medical-imaging-device purchase-analysis form. In view of the foregoing remarks, the issue of intended use is moot.

For at least these reasons, independent claim 1 and its dependent claims are believed to be allowable over the cited reference.

Features of Independent Claim 19 Missing From the Cited Combination

Claim 19 recites an interface, “wherein the interface includes a *medical-diagnostic-device purchase-analysis-form* having fields configured to enable selection of a prospective medical imaging system”. Claim 19 further recites a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging systems.”

In stark contrast, Eder is absolutely devoid of an interface which includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system. Similarly, Eder is devoid of a financial report tailored to such systems. *See, generally, Eder, col. 12, lines 32-67;*

Figures 1-9C. The cited reference clearly fails to disclose techniques for evaluating client data associated with a medical imaging system. The system disclosed by Eder is incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of *medical* imaging systems. The types of *interfaces* and *financial reports* recited in claim 19 are clearly structured or configured for *evaluating client data of a medical imaging system*, and are not a simple representation of applying the generic business accounting techniques disclosed in Eder to a medical imaging system. Rather, the claimed *interface* and *financial report* denotes types of interfaces and financial reports that are different than any interface or report described in the Eder reference.

Further, in rejecting the claim the Examiner pointed out that the Eder reference discloses the claimed “wherein the projected financial report enables a client to evaluate feasibility of purchasing the desired system.” Final Office Action, page 6. However, the Examiner does not appear to indicate where such disclosure is found in the Eder reference. The Applicants request the Examiner to specifically indicate where the claimed subject matter is indicated in the Eder reference. Absent any such disclosure, the rejection of claims 19 is improper and should be withdrawn.

In addition, the Examiner rejected the claim based on grounds of intended use. *See* Final Office Action, page 6. Applicants submit that Eder simply does not disclose an interface, wherein the interface includes a medical-diagnostic-device purchase-analysis-form. Therefore, the issue of intended use is irrelevant and should not constitute grounds for rejecting the claim. Accordingly, for at least these reasons, independent claim 19 and its dependent claims are believed to be allowable over the cited reference.

Features of Independent Claim 34 Missing From the Cited Combination

Claim 34 recites “providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective

medical imaging system” and a form for “entering *client data* relating to the healthcare facility including system operational data of the prospective medical imaging system.”

Conversely, the Eder reference does not teach or suggest a *form* for entering of client data related to a healthcare facility and/or a medical imaging system. Instead, as discussed above, Eder provides for forms to extract, aggregate and store transaction data associated with *intangible* assets (not system operational data). Eder, col. 8, lines 1-10; col. 5, lines 12-15.

Independent claim 34 further recites “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system.” The Eder system displays financial forecasts projecting a firm’s growth based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. Eder simply does not disclose returning a pro forma financial report, much less a pro forma financial report to enable a client to evaluate feasibility of a transaction to obtain a medical imaging system. Therefore, for at least these reasons, independent claim 34 and its dependent claims are believed to be allowable over the Eder reference.

Features of Independent Claim 43 Missing From the Cited Combination

Claim 43 recites “an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system”, wherein the entry fields include “a medical *operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction*.” Claim 43 further recites “a revenue field associated with the medical diagnostic system.”

In contrast, Eder does not teach or suggest an internet query *form* having data entry *fields* accepting financial data of a medical diagnostic system. Furthermore, Eder

clearly does not disclose a *system* for financially analyzing a potential purchase transaction of a prospective medical diagnostic system. Thus, Eder can not teach the related *Internet results page*. Again, Eder instead provides a financial forecast based on option pricing and cash flow analysis. Eder col. 6, lines 25-64.

Further, in rejecting claim 43, the Examiner used an intended use type argument. *See* Office Action, pages 11, 12. However, because Eder is devoid of an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data, such an argument can not stand in rejecting the claim. Therefore, for at least this reason and for those stated above, independent claim 43 and its dependent claims are believed to be allowable over the Eder reference.

Features of dependent Claim 53 Missing From the Eder

Claim 53 is directly dependent from claim 1. The claim recites “medical resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.” Again, Applicants respectfully submit the modalities recited in the above claim are not disclosed or suggested by the Eder and Javit references. More critically, the forms provided by these references are not suitable for providing fields to accept financial data including system operational data of imaging systems, such as MRI, CT, ultrasound or any combination thereof. For at least these reasons, independent claim 53 is believed to be allowable over Eder.

Request Withdrawal of Rejection

For these reasons, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Improper Combination - Lack of Objective Evidence of Reasons to Combine

In addition, the Examiner has not shown the requisite motivation or suggestion to modify the cited reference to reach the present claims. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited reference. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner modified the cited reference based, for example, on the *conclusory and subjective statement*, stating that “it would have been obvious to one of ordinary skill in the art to apply the modeling and analyzing business improvement programs thought by Eder to medical imaging financial system operation to enable medical care professionals to use a broad array of assumptions to forecast utilization of medical procedures and estimated revenue per procedure under multiple capitation scenarios and to provide for a more comprehensive and efficient system for financial/management analysis of medical business operations.” Final Office Action, page 4. Accordingly, Applicants challenge the Examiner to produce objective evidence of the requisite motivation or suggestion to modify the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

Conclusion

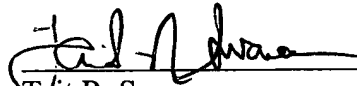
The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge any fees which may be required, to the Deposit Account No. 07-0845; Order No. GEMS:0122/SWA (15-EC-5773).

Respectfully submitted,

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